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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/521,871

01/21/2005

Norihisa Mino

10873.1596USWO

1262

52835

7590

05/18/2009

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EXAMINER

ONEILL, KARIE AMBER

ART UNIT

PAPER NUMBER

1795

MAIL DATE

DELIVERY MODE

05/18/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|----------------------------------------------------------------------------------------------|----------------------------------------------|--------------------------------------------|--|
| <p align="center">Advisory Action Before the Filing of an Appeal Brief</p> | <p>Application No. 10/521,871</p> | <p>Applicant(s) MINO ET AL.</p> | |
| | <p>Examiner Karie O'Neill</p> | <p>Art Unit 1795</p> | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 May 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Karie O'Neill
AU 1795

/Mark Ruthkosky/
Primary Examiner, Art Unit 1795

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant argues that Suzuki does not teach that "the water repellant substance covers an inside of the through holes formed within the base materials, as required by Claim 1." Applicant's argument is not persuasive. Suzuki discloses all of the structural features claimed by Applicant, and on page 5 of the Final Office Action, describes wherein the water repellant substance provided on a face of the organic layer on a side opposite to a face that is bonded to the base material, and the substance fills gaps present in an inner portion of the through holes. Because there is no indication of what type of material Applicant is calling a "water repellant", any number of possibilities are disclosed by Suzuki. For instance, a catalyst bed (44a) is formed on the face of the organic layer and includes a catalyst material (48a) made of platinum or a platinum alloy, which are water repellant materials, and an electrolyte material of a solid polymer electrolyte of a fluorine system and a solid polymer electrolyte of a hydrocarbon system which are represented by the perfluorocarbon-sulfonic acid system polymer are used. The electrolyte material and catalyst particles would inherently penetrate the base material (32) and fill gaps that are present in the inner through holes.

Applicants also argues that, "the electrolyte film of Claim 1 that includes the base material having through holes is a separate part from the electrodes and different from the electrolyte in the electrodes Suzuki discloses". Applicants argument is not persuasive. The catalyst bed (44a) formed on the face of the organic layer comprises electrolyte materials made from various solid polymer electrolyte materials. The catalyst bed (44a) makes up a layer of the overall anode (40a), but is a separate part from the hydrophobic layer (52a) and diffusion zone (42a). The materials of the catalyst bed (44a) most closely resemble the materials used for the electrolyte base material (32). Therefore, the electrolyte materials containing the catalyst particles and the electrolyte materials between electrodes can be the same material and function integrally. .